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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,680	01/15/2002	Thomas Joseph Pecorini	05015.0388U2	4839

22045 7590 01/06/2006

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,680

Applicant(s)

PECORINI ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,9-11,13-15 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,9-11,13-15 and 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 10-11, 13-15, and 18-25 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 54129050.

The rejection is adequately set forth in paragraph 5 of the office action mailed 5/24/05 and is incorporated here by reference.

3. Claims 1, 3, 10-11, 13, 15, 18-22, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 370424.

The rejection is adequately set forth in paragraph 6 of the office action mailed 5/24/05 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 3-5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 54129050 in view of EP 370424.

The rejection is adequately set forth in paragraph 9 of the office action mailed 5/24/05 and is incorporated here by reference.

6. Claims 4-5, 7, 9, 14-15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 370424.

The rejection is adequately set forth in paragraph 10 of the office action mailed 5/24/05 and is incorporated here by reference.

Response to Arguments

7. Applicants' arguments filed 10/27/05 have been fully considered but they are not persuasive.

Previously, the examiner argued with respect to both JP 54129050 and EP 370424 that given that each reference discloses polyester composition identical to that presently claimed, i.e. prepared from identical color concentrate and polyester, the composition would inherently possess same moisture content as presently claimed.

In response, in the amendment filed 10/27/05, applicants argue that neither JP 54129050 or EP 370424 are proper references against the present claims under 35 USC 102 given that neither reference discloses moisture content as presently claimed. Applicants further argue that given that moisture, like any other component in a composition can take on virtually any value, the requisite for inherency that the "unmentioned feature at issue is necessarily present in the reference" is not met.

However, it is the examiner's position that moisture content is inherent to the presently claimed polyester composition. Evidence to support this position is found in present claim 1, for instance, which recites that the concentrate "provides a polyester composition having a moisture content of less than about 0.1 wt%" when the concentrate is combined with a base polyester. Thus, it is clear that the concentrate determines the moisture content of the polyester composition. Further evidence to support this position is found in applicants' specification where Table 1 shows that the moisture content is dependent on the color concentrate utilized in the polyester composition. Thus, it appears that the moisture content of the polyester composition does depend on the color concentrate utilized.

Given that JP 54129050 and EP 370424 each disclose color concentrate identical to that presently claimed which is used in combination with polyester as presently claimed, it is clear that such concentrate would inherently provide a polyester composition having moisture content of less than about 0.1 wt.% when the concentrate is combined with base polyester as presently claimed. It is noted that the courts have held that "a compound and all its properties are mutually inseparable", *In re Papesch*, 315F.2d 381, 137 USPQ 42, 51 (CCPA 1963). Further, attention is drawn to MPEP 2112.01, which states that "products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present.", *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Further, given that JP 54129050 and EP 370424 each disclose color concentrate and polyester identical to that presently claimed, it is clear that one skilled in

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the art viewing either JP 54129050 or EP 370424 would understand that the unmentioned feature, i.e. moisture content, is necessarily present in each of the references.

In light of the above, the examiner's position remains that given that JP 54129050 and EP 370424 each disclose color concentrate as presently claimed, the color concentrate would inherently provide polyester having moisture content of less than about 0.1 wt.% as presently claimed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
1/3/06